

### **Remarks**

Reconsideration of the present application is respectfully requested in view of the foregoing amendments and following remarks. Claims 4-7 and 13-26 remain in the application.

### **Cited Art**

The Office action cites Herz, U.S. Patent No. 5,758,257; Ellis, U.S. Patent No. 6,898,762; Yoshinobu, U.S. Patent No. 5,734,444; Alexander, U.S. Patent No. 6,177,931; Smith, U.S. Patent No. 5,933,141; and Daniels, U.S. Publication No. 2002/0032907.

### **Claim Objections**

The Examiner objected to claims 14 and 26. In response, claim 14 has been amended in order to eliminate the antecedent basis problem. Additionally, claim 26 was added back into the case as requested by the Examiner.

### **Claim Rejections under 35 U.S.C. § 103**

All claims stand rejected under 35 U.S.C. § 103 based on a combination of the "Cited Art" mentioned above. In particular, the Examiner rejected all claims based, in part, on Ellis et al., U.S. Patent No. 6,989,762 (hereinafter Ellis). Applicant's believe that Ellis is an improper reference under 35 U.S.C. § 103.

Ellis was filed August 13, 1999, and claims priority to Provisional Application No. 60/097,538, which is attached. As can readily be seen, the Provisional Application is only a single page in length filled with ideas and little substance or support. In particular, the Examiner relies on sections of Ellis that are clearly not disclosed in the 1-page provisional application. For example, the Office action (at page 4, first paragraph) cites Ellis Column 7, lines 50-56; Column 4, lines 49-60; Column 12, lines 45-49; Column 10, lines 46-50; Column 12, lines 32-43; and Column 19, lines 51-60. None of this information appears to be properly supported in the provisional application.

Without proper support from the provisional application, Ellis must be used only based on its filing date of August 13, 1999, which is after the priority date of the present application. More particularly, the present application is a divisional of U.S. Patent No. 09/201,495 filed November 30, 1998.

Moreover, it is believed that the Ellis provisional application is not enabling:

"In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. <Mayo Found. For Med. Educ. & Research>*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003) (At issue was whether a prior art reference enabled one of ordinary skill in the art to produce Elan's claimed transgenic mouse without undue experimentation. Without a disclosure enabling one skilled in the art to produce a transgenic mouse without undue experimentation, the reference would not be applicable as prior art.). A reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention." *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

M.P.E.P. § 2121.01

The single-page disclosure of the Ellis provisional application is clearly not sufficient to build a client/server based electronic program guide without undue experimentation.

**Conclusion**

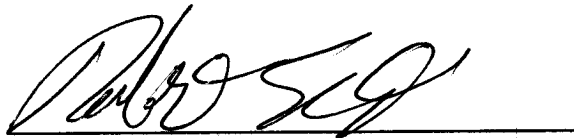
Applicants respectfully request that the Examiner withdraw the current Office action and issue a Notice of Allowance.

Respectfully submitted,

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By

A handwritten signature in black ink, appearing to read 'R. F. Scotti', is written over a horizontal line.

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08/21/98

1578 U.S. PTO



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# PROVISIONAL APPLICATION FOR PATENT COVER SHEET

This is a request for filing a PROVISIONAL APPLICATION FOR PATENT under 37 CFR 1.53 (b)(2).

Docket Number UV-97 Prov. Type a plus sign (+) inside this box →

## INVENTOR(s)/APPLICANT(s)

| LAST NAME | FIRST NAME | MIDDLE NAME/INITIAL | RESIDENCE (CITY AND EITHER STATE OR FOREIGN COUNTRY) |
|-----------|------------|---------------------|--|
| Ellis     | Michael    | D.                  | Boulder, Colorado                                    |
| Lemmons   | Thomas     | R.                  | Sand Springs, Oklahoma                               |
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## TITLE OF THE INVENTION (250 characters max)

CLIENT/SERVER BASED ELECTRONIC PROGRAM GUIDE

## CORRESPONDENCE ADDRESS (including country if not United States)

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## ENCLOSED APPLICATION PARTS (check all that apply)

|   |                  |   |   |
|---|------------------|---|---|
| <input checked="" type="checkbox"/> Specification | Number of Pages  | 1 | <input type="checkbox"/> Small Entity Statement   |
| <input type="checkbox"/> Drawing(s)               | Number of Sheets |   | <input type="checkbox"/> Other (specify) <span style="border: 1px solid black; display: inline-block; width: 150px; height: 1.2em; vertical-align: middle;"></span> |

## METHOD OF PAYMENT OF FILING FEES FOR THIS PROVISIONAL APPLICATION FOR PATENT (check one)

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| <input checked="" type="checkbox"/> A check or money order is enclosed to cover the filing fee  | FILING FEE AMOUNT (\$) | 150.00 |
| <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge filing fees and credit Deposit Account Number: <span style="border: 1px solid black; padding: 0 20px;">06-1075</span> |                        |        |

The invention was made by an agency of the United States Government or under a contract with an agency of the United States Government.

☒ No.

☐ Yes, the name of the U.S. Government agency and the Government contract number are: \_\_\_\_\_

Respectfully submitted,

SIGNATURE

*G. Victor Treyz*

Date

8/21/98

TYPED or PRINTED NAME

G. Victor Treyz

REGISTRATION NO.  
(if appropriate)

36,294

☐ Additional inventors are being named on separately numbered sheets attached hereto

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Client/Server Based Electronic Program Guide

Electronic program guides typically run locally to a user's television or computer device. However, since the processing and storage capabilities of a television settop, receiver, or digital television are generally quite limited, the functionality of the guide on such a platform is significantly limited.

Television platforms being developed today support a return path. This will allow a program guide to use a remote server to augment its local processing and storage capabilities.

There are many possible methods for the settop/receiver to communicate with a remote server. This might include a connection over the cable return path, a telephone modem, or an in-home network to a local PC that has an Internet connection.

There are many possible new features available when a remote server is used to add processing and/or storage capacity:

- Listings data may be filtered based on profiles stored remotely. Only data that is of interest to the viewers of the household needs to be stored locally. In addition, the guide might store only the next few hours of data locally, and retrieve any later data from the server only when needed. This less used data would then not use significant local memory or bandwidth.
- The viewer may set up complicated searches and sorts of programming information. For example, the viewer may wish to list all John Wayne western comedies on tonight starting between 7:00 and 8:00 and ending between 9:00 and 9:30.
- The viewer may set up smart "agents" to track down programming information. For example, the viewer may wish to be notified whenever there is a program on which discusses model ship building, as long as it is not rated R or higher.
- The guide may track viewing history on the server. This may be used for such purposes as:
  - Identifying which programs or series episodes household members have viewed, so new episodes can be presented differently.
  - Providing viewing recommendations based on what shows have been watched when, and by whom. The guide might also allow the viewer to indicate which shows were liked and disliked, to allow a more accurate recommendation to be made.
  - Targeting advertising based on viewing history.
  - Collecting program ratings information.
- The guide may make automatic personalized program recommendations, based both on user profiles stored on the server and on viewing history stored on the server.
- Viewers may develop complicated criteria for reminders and automatic recordings. For example, the viewer may wish to record any comedy with Garry Shandling, as long as it hasn't been recorded yet.
- The guide might offer more parental control options, for example, lockout by actor. The guide might also allow the storage of more individual criteria, such as allowing many individual program titles to be blocked.
- A server may facilitate the linking of multiple data sources. For example, a server might allow the guide to retrieve information from the Internet to augment the standard listings data.

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